

### REMARKS

This Application has been carefully reviewed in light of the Office Action mailed January 9, 2009. At the time of the Office Action, Claims 1-15 were pending in this Application. Claims 1-15 were rejected. Claims 1, 13, and 14 are herein amended; Claims 10 and 11 are herein cancelled without prejudice or disclaimer; and new dependent Claim 16 is added. Applicants respectfully request reconsideration and favorable action in this case.

#### **Rejections under 35 U.S.C. §§ 102 and 103**

Claims 1, 2, and 9-11 were rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by German patent DE 3711393 issued to Bortolan. ("*Bortolan*").

Claims 1 and 8 were rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 3,121,569 issued to Weber et al. ("*Weber*").

Claims 3, 5, and 12 were rejected by the Examiner under 35 U.S.C. §103(a) as being unpatentable over *Bortolan*.

Claims 4, 6, and 7 were rejected by the Examiner under 35 U.S.C. §103(a) as being unpatentable over *Bortolan* in view of U.S. Patent 6,273,430 issued to Kanari et al. ("*Kanari*").

Claims 13 and 15 were rejected by the Examiner under 35 U.S.C. §103(a) as being unpatentable over German patent application DE 10162045 by Schurz ("*Schurz*") in view of *Bortolan*.

For prior art based rejections under either 35 U.S.C. §102 or 35 U.S.C. §103, the prior art reference(s) much teach every limitation of the claim at issue. Regarding rejections under 35 U.S.C. §102, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "the identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Similarly, regarding rejections under 35 U.S.C. §103, in order to establish a prima facie case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Applicants respectfully submit that none of the cited references (*Bortolan*, *Weber*, *Kanari*, and *Schurz*), alone or in combination, teach every element of Applicants' claims as amended.

For example, amended Claim 1 recites:

1. A device for providing sealing in an injection valve system including a housing, a first plunger, and a second plunger that translates relative to the first plunger during operation, the device comprising:

a first body which has a recess;

a second body which is introduced into the recess, wherein the second body moves relative to the first body during translation of the first plunger relative to the second plunger; and

an elastomer, which is inserted between the first and second body in the recess and thus in this area, closes and seals the space between the first and second body, wherein the elastomer comprises a first groove extending at least partly along the recess while located at a distance from the wall of the recess;

an elastomer seal positioned to close and seal the space between the first and second bodies;

a fluid chamber defined between the first plunger and the elastomer seal, wherein the elastomer seal prevents fluid in the fluid chamber from flowing past the elastomer seal and out of the fluid chamber; and

a tensioning means configured to support the elastomer seal in the space between the first and second bodies.

The cited references do not teach these features of amended Claim 1. For example, none of the cited references teach "a tensioning means configured to support the elastomer seal in the space between the first and second bodies." *Bortolan*, *Weber*, and *Kanari* do not teach anything similar to a tensioning means acting on an elastomer seal. *Bortolan* teaches a spring 31 that acts on "coupling ring" 23 and "balance chamber" 26, but does not act on an elastomer seal that provides a seal between first and second bodies, much less a seal between

first and second bodies that move relative to each other during translation of a plunger. If the Examiner believes that the references do teach this limitation, Applicants respectfully request that the Examiner identify the specific elements that can be equated with (a) the first body, (b) the second body, (c) the elastomer seal, and (d) the tensioning means.

As another example, none of the cited references teach “a fluid chamber defined between the first plunger and the elastomer seal, wherein the elastomer seal prevents fluid in the fluid chamber from flowing past the elastomer seal and out of the fluid chamber.” None of *Bortolan*, *Weber*, and *Kanari* teach an elastomer seal that forms a seal to prevent fluid from flowing out of a chamber defined between the elastomer seal and a plunger. If the Examiner believes that the references do teach this limitation, Applicants respectfully request that the Examiner identify the specific elements that can be equated with the (a) first plunger, (b) the elastomer seal, (c) the fluid chamber defined between the plunger and the elastomer seal, and (d) the elastomer seal preventing fluid from flowing past the elastomer seal and out of the fluid chamber.

For at least these reasons, Applicants submit that the amended Claim 1 is allowable over the cited references. Thus, Applicants respectfully request reconsideration and allowance of amended Claims 1, as well as all claims that depend therefrom. In addition, for analogous reasons, Applicants respectfully request reconsideration and allowance of amended independent Claims 13 and 14, as well as all claims that depend therefrom.

### **Double Patenting Rejection**

The Examiner provisionally rejected Claims 1 and 13 based on the judicially created double patenting doctrine over Claims 3 and 1, respectively, of U.S. Patent 7,017,346 (hereinafter “*Schurz* ‘346”). (Office Action, page 2).

Applicants respectfully traverse the rejection. Amended Claim 1 recites “wherein the elastomer comprises a first groove extending at least partly along the recess while located at a distance from the wall of the recess.” Similarly, amended Claim 13 recites “the elastomer seal including a first groove extending at least partly around the seal and located at a distance from an outer wall of the seal.” Claims 3 and 1 of *Schurz* ‘346, as well as the remainder of *Schurz* ‘346, do not teach an elastomer seal having a groove at all, much less a groove

extending at least partly along a recess and located at a distance from a wall of the recess, or extending at least partly around the seal and located at a distance from an outer wall of the seal. For at least these reasons, Applicants submit that the amended Claims 1 and 13 are allowable over *Schurz* '346.

### CONCLUSION

Applicants have made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicants respectfully request reconsideration of the pending claims.

Applicants respectfully submit a Petition for Two-Month Extension of Time. The Commissioner is authorized to charge the fee of \$490.00 required to Deposit Account 50-4871 of King & Spalding LLP in order to effectuate this filing. Applicants believe no other fees are due; however, should the Commissioner deem that any additional fees are due, including any fees for any additional extensions of time, the Commissioner is hereby authorized to debit said fees from deposit account number 50-4871.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512-457-2030.

Respectfully submitted,  
KING & SPALDING LLP



Attorney for Applicants  
Eric M. Grabski  
Registration No. 51,749

Date: June 9, 2009

SEND CORRESPONDENCE TO:

KING & SPALDING L.L.P.

401 Congress Ave., Suite 3200

Austin, TX 78701

CUSTOMER ACCOUNT NO. **86528**

512-457-2030

512-457-2100 (fax)